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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/495,655	02/01/2000	Douglas G. Elliot	2316.1151US01	5142
23552	7590	09/22/2005	EXAMINER	
MERCHANT & GOULD PC			HAMMOND, BRIGGITTE R	
P.O. BOX 2903			ART UNIT	
MINNEAPOLIS, MN 55402-0903			PAPER NUMBER	

2833

DATE MAILED: 09/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/495,655

Applicant(s)

ELLIOT ET AL.

Examiner

Brigitte R. Hammond

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 July 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6, 12, 13, 16, 17, 22-25 and 32-34 is/are rejected.
- 7) ☒ Claim(s) 7-9, 14, 15, 18-21 and 26-31 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 July 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 22-25 and 32-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Robinson et al. 5,781,686. Regarding claim 22, Robinson et al. disclose an outlet box 10 comprising: a housing 36,28 including a first side positioned opposite from a second side, at least one of the first and second sides forming a base 28 of the housing, a peripheral wall that extends between the first and second sides of the housing, the peripheral wall including, a first portion having a first outer face that extends between oppositely positioned first and second edges, the first and second edges being oriented to extend between the first and second sides of the housing, the first portion defining a connector access opening longitudinally between the first and second edges of the first outer face, a second portion having a second outer face separate from the first outer face, the second outer 158 that is elongated and that extends face being configured to extend about a periphery of the housing from the first edge to the second edge; a connector holder 30 connected to the housing and positioned adjacent to the connector access opening of the housing', and C) at least four break-outs 40 provided on the second portion of the peripheral wall, the break-outs being

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adapted to form openings in the peripheral wall that face outward from the housing in different directions. (Robinson discloses the break-outs being adapted to form openings in selected sides of the wall (col. 5, line 55)). Regarding claim 23, Robinson et al. disclose a connector holder 34 for holding a plurality of telecommunications connectors 18, a housing defining an elongated connector access opening 158, the housing also including a base 22 that defines a first elongated mounting opening (at) 32 positioned adjacent to the connector access opening 158, the first mounting opening extending completely through the base, and the connector access opening and the first mounting opening being elongated in the same direction; and the connector access opening and the base being positioned perpendicularly relative to each other and the connector holder 34 including an elongated base 92 sized and shaped to complement the first mounting opening, wherein the elongated base of the connector holder fits within the first mounting opening to mount the connector holder to the housing.

Regarding claim 24, the base of the connector holder snap-fits within the first mounting opening.

Regarding claim 25, further comprising holder mounts that define mounting channels positioned on opposite ends of the first mounting opening, the holder mounts projecting outward from the base of the housing and including locking shoulders positioned within the channels (not numbered, for locking members of connector holder 34, shown near 34 in fig. 1), the connector holder 34 including oppositely positioned, resilient locking members (not numbered) that fit within the channels and interlock with the locking shoulders positioned within the channels.

Regarding claim 32, Robinson et al. disclose an outlet box comprising: A) a connector holder 34 for holding a plurality of telecommunications connectors 18, a housing defining a connector access opening 158; means (cantilevered fingers on the holder) for mounting the connector holder at first and second locations in the housing that is adjacent to the connector access opening, wherein a user can mount the connector holder at either one of the first and second locations.

Regarding claim 33, Robinson et al. discloses a method for assembling an outlet box including a housing defining connector access opening, the housing also including a first connector mounting location 86 positioned adjacent the connector access opening and a second connector mounting location 88 recessed within the housing relative to the first connector mounting location, the method comprising: providing a connector holder 34 adapted for holding a plurality of telecommunications connectors 18; selecting one of the first and second connector mounting locations; and mounting the connector holder at the selected one of the first and second connector mounting locations.

Regarding claim 34, Robinson et al. disclose an outlet box comprising a connector holder 34 for holding a plurality of telecommunications connectors 18, a housing defining a connector access opening 158, a first connector holder mount 98 positioned at a first location that is adjacent to the connector access opening, and a second connector holder mount positioned at a second location that is recessed within the housing relative to the first location, wherein a user can mount the connector holder at either one of the first and second locations.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-6, 12 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Robinson et al. 5,781,686 in view of Prazoff 6,077,109. Robinson et al. discloses the invention substantially as claimed. Robinson et al. discloses an outlet box comprising: a housing including: a) a first side positioned opposite from a second side, at least one of the first and second sides containing a base 22 of the housing; b) a peripheral wall that extends between the first and second sides of the housing, the peripheral wall including: a first portion having a first outer face that extends between oppositely positioned first and second edges, the first and second edges being oriented to extend between the first and second sides of the housing, the first portion defining a connector access opening 158 that is elongated and that extends longitudinally between the first and second edges of the first outer face; a second portion 156 having a second outer face separate from the first outer face, the second outer face being configured to curve about a periphery of the housing from the first edge to the second edge; and a connector holder 34 connected to the housing and positioned adjacent to the connector access opening 158 of the housing. Robinson et al. do not disclose the second outer face of a peripheral wall being shaped to curve continuously about a periphery of the housing. However, Prazoff 6,077,109 discloses a peripheral wall 51 that is shaped to

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curve continuously about a periphery of a housing. Therefore, it would have been obvious to one of ordinary skill to modify the wall of Robinson et al. by shaping the wall with a different type of configuration (a continuous curve), since applicant has presented no explanation that this particular configuration of the wall is significant or is anything more than one of numerous configurations a person of ordinary skill in the art would find obvious as a design choice as taught by Prazoff. A change in shape is generally recognized as being within the level of ordinary skill in the art. In re Dailey, 149 USPQ 47 (CCPA 1976).

Regarding claim 2, the first side of the housing forms the base 28, and the second side of the housing 154 is planar.

Regarding claim 3, the first side of the housing forms the base 28, and the peripheral wall and the second side of the housing 154 are part of a cover 36 that is removable from the base.

Regarding claim 4, the first outer face is planar.

Regarding claim 5, the housing includes a first mounting structure 98 for mounting the connector holder 34 directly adjacent to the connector access opening, and a second mounting structure 98 for mounting the connector holder at a position that is recessed within the housing relative to the first mounting structure.

Regarding claim 6, the connector holder defines an array of openings in which the connectors are mounted.

Regarding claim 12, at least one raceway insertion location 40 defined at the second portion of the peripheral wall.

Regarding claim 13, wherein the at least one raceway insertion location 40 includes a plurality of raceway insertion locations that are spaced-apart along the second portion of the peripheral wall.

Allowable Subject Matter

Claims 7-9, 14, 15, 18-21 and 26-31 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claim 16 and 17 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Response to Arguments

Applicant's arguments filed July 5, 2005 have been fully considered but they are not persuasive. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., curve is continuous "only on the second wall) are not recited in the rejected claim. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

In response to applicant's argument that Prazoff is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention.

See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, the prior art of record disclosed the invention substantially as claimed except for the shape of the connector housing. Prazoff was cited for a connector housing of a curved shape. Therefore the rejection is proper.

In response to applicant's argument that Robinson does not disclose breakouts on four sides. The Examiner disagrees, Robinson discloses the break-outs being adapted to form openings in selected sides of the wall (col. 5, line 55).

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

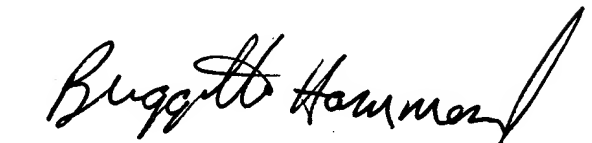
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Briggitte R. Hammond whose telephone number is 571-

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272-2006. The examiner can normally be reached on Mon.-Thurs. and Alternate Fridays from 7:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paula A. Bradley can be reached on 571-272-2800 ext. 33. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Brigitte R. Hammond
Primary Examiner
Art Unit 2833

September 19, 2005